

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
03-509-A

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on \_\_\_\_\_

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name \_\_\_\_\_

Application Number  
09/972,424

Filed  
October 4, 2001

First Named Inventor  
Chris E. Matichuk

Art Unit  
2145

Examiner  
Azizul Q. Choudhury

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW ACCOMPANYING NOTICE OF APPEAL**

I am the

☐ applicant/inventor.

/George I. Lee/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

George I. Lee

Typed or printed name

☒ attorney or agent of record.

Registration number 39,269

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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

April 22, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(MBHB 03-509-A)**

In the Application of:	)	
Chris E. Matichuk	)	Examiner: Azizul Q. Choudhury
	)	
Serial No.: 09/972,424	)	Group Art Unit: 2145
	)	
Filing Date: October 4, 2001	)	
	)	Confirmation No.: 8244
For: One Click Web Records	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW ACCOMPANYING  
NOTICE OF APPEAL**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

SIR:

**ERRORS IN THE PRIOR REJECTION**

Consistent with the Review Requirements for identification of clear errors, Applicants note the following clear errors set forth in the January 22, 2009 Final Office Action:

The Examiner's rejection of claims 1-40 under 35 U.S.C. § 103(a) as being unpatentable over the prior art references of Killian (U.S. Pat. No. 6,163,316) and Klosterman (U.S. Pat. No. 5,940,073) is clearly based on factual errors and should be reversed by the Panel.

### **REMARKS**

Applicants respectfully request reconsideration of Examiner's rejection of claims 1-28 and 33-40 under 35 U.S.C. §103(a). The Examiner has rejected these claims in view of the cited prior art references of Killian and Klosterman.

Applicants submit that the Examiner has failed to assert a prima facie case of obviousness for at least the reason that Killian and Klosterman, considered individually or in combination, fail to disclose each and every element of the claimed invention. Applicants do not concede that one of ordinary skill in the art would have combined the Killian and Klosterman references as asserted by the Examiner. However, even if, hypothetically and only for the purposes of this Pre-Appeal Brief Request for Review, the references were combined, the combination would still fail to disclose each and every element of the claims 1-28 and 33-40.

#### **A. The §103(a) Prior Art Rejection of Claims 1-28 and 33-40 Is Clearly Based on Factual Error**

The Examiner conceded on page 4 of the last Office Action that Killian fails to teach the selection of an advertisement to start the scheduling of the recording of the programming. This is a feature recited in independent claims 1, 19, 24, 33, 35 and 37. Accordingly, the Examiner relies upon Klosterman for teaching this feature.

##### **1. Klosterman Fails to Teach Selecting an Advertisement to Schedule the Recording of the Programming**

On page 4 of the Office Action, the Examiner states that Klosterman discloses while viewing through the computer, the user is allowed to click on an advertisement which allows the remote (the recording device can be disparate from the computer) automatic scheduling of the recording of the informercial/program, citing column 2, lines 14-17. The cited portion of

Klosterman states “if the information region contains advertising information *regarding a product*, the user may click on the information region to see a billboard or schedule a recording of an *informercial* on the product.”

Applicants submit that the Examiner’s citation of Klosterman for teaching the claimed limitation of “enabling selection of the advertisement; and in response to selection of the advertisement, automatically remotely programming the media-based device to record the broadcast program at the predetermined start time” or language to that effect as recited in independent claims 1, 19, 24, 33, 35 and 37, is clearly based on factual error for at least two reasons.

**2. Klosterman Does Not Teach Clicking On an Advertisement for a Broadcast Program**

First, Klosterman teaches that the user may click on the information region to schedule a recording for an infomercial on a product, “*if the information region contains advertising information regarding a product*” col. 2, lines 14-17. Applicants submit that because Klosterman is directed at an electronic program schedule guide, wherein the program guide has information regions for additional information, *a product* is different from *a broadcast program* on the program guide. As such, Klosterman is expressly directed toward selecting a *product*. As discussed below, Klosterman does not teach clicking on an advertisement for a broadcast *program* to schedule recording of the program itself.

**3. Klosterman Does Not Teach Clicking On an Advertisement for a Broadcast Program to Schedule Recording the Actual Program Itself**

Moreover, Klosterman teaches clicking on the advertisement for the product to see a billboard or schedule a recording of an *informercial* on the product. Applicants submit that even

if, hypothetically and only for the purposes of this brief, *a product* is construed as *a broadcast program*, Klosterman teaches clicking on an advertisement of the product/program resulting in recording of the infomercial/trailer of the program. Col. 2, lines 14-17. Klosterman does not teach that clicking on the advertisement results in scheduling the recording of the actual broadcast program itself. Rather, clicking on the program obtains more information about the program (billboard or infomercial), not recording the advertised program itself.

In other words, the relationship of what is clicked and what is recorded in Klosterman (advertisement for product/infomercial on the product) is differs from claims 1-28 and 33-40 recitation of what is clicked and what is recorded.

For at least the reasons stated above, Applicants submit that the Examiner's rejection of claims 1-28 and 33-40 is clearly based on factual errors and should be overturned by the Panel.

As such, Applicants submit that Klosterman fails to make up for the deficiencies of Killian and that accordingly, the Examiner's rejection of claims 1-28 and 33-40 is clearly based on factual errors and should be overturned by the Panel.

For at least this reason, Applicants submit that the Examiner's rejection is clearly erroneous and should be overturned by the Panel.

Respectfully submitted,

McDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP

Date: April 22, 2009

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